

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

TRANSACTIONSECURE LLC,
Patent Owner.

IPR2020-00321
Patent 8,738,921 B2

Before THOMAS L. GIANNETTI, CHRISTA P. ZADO, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

JUDGMENT

Granting Request for Adverse Judgment Prior to Institution of Trial
37 C.F.R. § 42.73(b)

On December 31, 2019, Unified Patents, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1, 4–8, 10, 15, 17, and 20–23 of U.S. Patent No. 8,738,921 (“the ’921 Patent”). On January 17, 2020, the Board issued a

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Notice of Filing Date, advising the Patent Owner of the requirement to submit mandatory notice information under 37 C.F.R. § 42.8(a)(2) within 21 days of service of the Petition. Patent Owner did not file the required mandatory notice by the due date, January 21, 2020.

Accordingly, the Board held a telephone conference with counsel for the parties on July 1, 2020. Jason Mudd of Erise IP, P.A. appeared on behalf of Petitioner and R. Burns Israelsen of Maschoff Brennan (Patent Owner's counsel of record with the United States Patent and Trademark Office for the challenged patent) appeared on behalf of Patent Owner. During the conference, counsel for Patent Owner stated that he is representing Patent Owner and that Patent Owner has elected not to participate in the proceeding and agreed to entry of adverse judgment against Patent Owner. Counsel for Petitioner did not object to entry of adverse judgment.

A party may request judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). Actions construed as a request for entry of adverse judgment include “[a]bandonment of the contest.” *Id.* Counsel for Patent Owner has stated that Patent Owner has elected not to participate in this proceeding, and has agreed that the Board should enter adverse judgment against Patent Owner. Therefore, we determine that Patent Owner has abandoned the contest and that entry of adverse judgment against Patent Owner is appropriate. *See Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018).

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Accordingly, it is

ORDERED that adverse judgment is hereby entered against Patent Owner pursuant to 37 C.F.R. § 42.73(b) with respect to claims 1, 4–8, 10, 15, 17, and 20–23 of U.S. Patent No. 8,738,921; and

FURTHER ORDERED that this proceeding is *terminated*.

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PETITIONER

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